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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/590,692 06/09/00 KEMP

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EXAMINER

WEISBERGER, R

ART UNIT

PAPER NUMBER

2164

DATE MAILED: 06/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/590,692

Applicant(s)

Kemp et al.

Examiner

Weisberger Richard C.

Group Art Unit

2164



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) 1-21 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 22-40 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Claims 1-21 drawn to a graphical user interface are classified in class 345, subclass 327.
  - II. Claims 22-40 drawn to a method, computer readable medium, and client server system for placing a trade order, are classified in class 705, subclass 37.
1. The inventions are distinct, each from the other because of the following reasons:  
Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the inventions have different effects.
  2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
  3. During a telephone conversation with Robert Klinger on May 22, 20001 a provisional election was made without traverse to prosecute the invention of Group II, claims 22-40. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Examiner Requirements for Information (Rule 1.105)

1. The trade name or industry name or company name of the inventions of claims 22-40.
2. All non-patent literature used/relied upon or otherwise related to the drafting of the instant application.
3. All non-patent literature used/relied upon or otherwise related to the drafting of the invention of claims 22-40.
4. What specifically is being improved upon in the method for placing a trade order, a computer readable medium having program code for placing a trade order, and a client system for placing a trade order.
5. All non-patent literature, (i.e. conference papers, presentations, product brochures etc. ) used in the invention process including {such as designing around or providing a solution to accomplish the claimed invention)
6. Notwithstanding the dates of uses, submittal, or disclosure, any use of the claimed invention, any proposals submitted to corporate partners for the use or development of the claimed

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invention, any papers presented to industry groups and/consortiums describing the claimed invention.

***Claim Rejections - 35 USC § 112***

5. Claims 22-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The claim limitations “dynamic display” and “static display” are vague and indefinite. The applicant is requested to claim “to what extent”, “to what degree”, and “on what basis” the displays “change”.

B. The *scope* of a “single action” (i.e. claim 23) is unclear.

C. The limitation “based in part” (i.e. claim 23) is vague indefinite and not defined.

D. The claim limitation “current net position” (i.e. claim 25) is not defined.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 22-40 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over -----

[http://www.tradingtechnologies.com/products/xtrade\\_full.html](http://www.tradingtechnologies.com/products/xtrade_full.html) (viewed on 6/01/2001)

The applicant's claims are directed to a method for placing a trade order, a computer readable medium having program code for placing a trade order, and a client system for placing a trade order. These three inventions share common limitations and for the most part run parallel. Thus, prior art that discloses the method should inherently teach the computer readable medium and the client system. The prior art (the X trader system) teaches a method comprising the steps of displaying a market depth (see, bid price and ask price column), initiating a trade order with a single action (see, single click trading feature) and wherein the contents of the trade order are based in part of the preset parameters and the position of the pointer. Moreover, the method is said to include methods of performing both click trades and dime trades with the use of the +/- parameter.

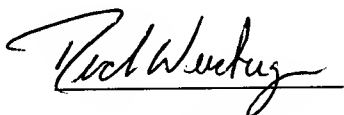
Due to the static representation of the prior art, it is difficult to determine if the claim limitations are inherent to or obvious from the X trader system. While the fact patterns are not exactly analogous, the courts have held that where the claimed and prior art products are identical

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or substantially identical in structure or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness will be considered to have been established over functional limitations that stem from the claimed structure. In re Best, 195 USPQ 430, 433 (CCPA 1977), In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). And the court offered the applicant a remedy for overcoming this rejection by asserting that the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977). Accordingly, it seems appropriate based in on the co-ownership of the prior art and the claimed invention for the applicant to supply evidence showing that the prior art X Trader system does not possess the characteristics of the claimed product.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as each establishes a publication date for the X trader to be more than one year prior to the June 9, 2000 filing date of the instant application.

Respectfully;

A handwritten signature in cursive script, appearing to read "Rich Weisberger", written in black ink.

Rich Weisberger

703 308 4408

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